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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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Application Number

10/628,891

Filed

28 July 2003

on _____

First Named Inventor

Robert L. Demchick

Signature _____
Typed or printed
name _____

Art Unit

3753

Examiner

A. Michael Chambers

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record. Registration number 52,808 attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Paul H. Demchick

Typed or printed name

252-291-2140

Telephone number

03 February 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Before the United States Patent and Trademark Office

Regarding:

Application Number: 10/628,891

Filing Date: 28 July 2003

Applicant: Robert L. Demchick

Title: Recreational Vehicle Equipped with Exterior Water Outlet

Art Unit: 3753

Examiner: A. Michael Chambers

Reasons

Pre-Appeal Brief Conference

Although there are various arguments and forms of evidence that the applicant would present in a full review of the rejections of his claims, the reasons for this requested Pre-Appeal Brief Conference are limited to two clear errors in the rejections. Either of those errors would render the rejections inappropriate. The applicant respectfully submits that those errors are:

- Examiner has failed to meet the standards required for establishment of a *prima facie* case for rejection of claims under 35 U.S.C. §103. More specifically, the Examiner has failed to cite a motivation to combine references.

- The references combined are nonanalogous arts and the problems solved in the references are neither the same as, nor analogous to, the problems solved by the invention disclosed in application 10/628,891.

Regarding the lack of cited motivation:

No motivation is found in Eisner or in Reid for combining the teachings of those references. No other reference is cited indicating such motivation. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986) MPEP § 2142.

The showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998). The showing of a suggestion, teaching, or motivation to combine the prior art references must be clear and particular. Broad statements about the teaching of multiple references, standing alone, are not evidence. *Dembiczak*, 175 F.3d at 1000, 50 USPQ2d at 1617. "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) MPEP § 2144.04 VI C "The combination of elements from non analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the

prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself." *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

The invention described in application 10/628,891 is one of those in which an important aspect of the invention process was the recognition of a long-standing, unrecognized problem. Although the mechanical solution was fairly simple, there is no indication cited that the problem solved was recognized in the art. The nature of the use of the invention disclosed by Eisner and the nature of the use of the invention disclosed in Application 10/628,891 would indicate that the reason for the placement of the water inlet and mixture outlet of Eisner could not possibly be the same or analogous to the reason for the placement of the water inlet and water outlet of the invention disclosed in Application 10/628,891. Eisner was clearly not addressing the matters of convenience or sanitation based on camping site and RV configurations addressed by the invention disclosed in 10/628,891. Those issues are discussed in detail in Application 10/628,891.

During a telephonic interview on 23 January 2006, the Examiner explained that the motivation is, as stated in the application, the increased convenience of the invention. Examiner agreed that no motivation was found or cited in any reference, but that the motivation mentioned in the application was sufficient for the rejection. The applicant respectfully disagrees.

Regarding the combination of references from nonanalogous arts:

The waterproofing material pumping systems art is a nonanalogous art to the recreational vehicle art to which the invention disclosed in application 10/628,891 pertains. Those skilled in the recreational vehicle art would not be reasonably expected to look to waterproofing material pumping systems to

solve the sort of problem of user convenience and sanitation based on campsite and RV configuration addressed in application 10/628,891.

In fact even if one in the recreational vehicle art did look to the waterproofing material pumping systems art, the invention disclosed by Eisner was not addressing the same issues as addressed by the invention disclosed in application 10/628,891.

"In resolving the question of obviousness under 35 U.S.C. 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved." *In re Wood*, 202 USPQ 171, 174 (C.C.P.A. 1979).

The examiner concludes that the arts are analogous based on the fact that both are "wheeled fluid systems." This category is too broad to define an analogous area of art. That broad category would encompass not only waterproofing material pumping systems and recreational vehicles but certain irrigation equipment, toy fire trucks, insulated water containers with wheels (such as those used by sports teams), port-a-potties, many household dehumidifiers, the space shuttle, automobiles equipped with windshield washers, cement mixer trucks, rolling mop buckets, and gas grills. That is clearly too broad.

The leap from waterproofing material pumping systems to recreational vehicles is greater than leaps that have been deemed too great for arts to be considered analogous. One type of filter has been held not to be analogous art to another type of filter. *Ex parte Re Qua*, 56 USPQ 279, 280 (Pat. Off. Bd. App. 1942). One type of memory circuit in computers has been held not to be analogous art to

another type of memory circuit in computers. *Wang Labs., Inc. v. Toshiba Corp.*, 26 USPQ 2d 1767, 1773 (Fed. Cir. 1993).

In arguing that the Reid and the Eisner references are analogous, the Examiner depends on the alleged fact that both are in USPTO classification 137. However, USPTO classification is of limited value in determining analogy **MPEP § 2144.01**. Moreover, it is respectfully submitted that the current classification for Eisner is 137/267; 137/565.17; 137/899, while the current classification for Reid is 4/663; 4/209FF; 4/323; 4/415; 4/626; 4/664; 4/665.

Although the invention disclosed by Eisner and the invention disclosed in application 10/628,891 both include liquid handling systems, the problem solved by the invention disclosed in application 10/628,891 is quite different from the problem solved by the invention disclosed by Eisner. Both address problems quite different from those addressed in application 10/628,891.

Respectfully submitted,



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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, FAX Number 571 273 8300 on 03 February 2006.



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